IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF APPEALS

Applicant(s):	Donald E. Wallar II
Serial No.:	09/471,429
For:	MESSAGE COMPOSITION FOR COMPUTER, MEDIA AND METHOD
Filed:	December 23, 1999
Examiner:	Sanjiv Shah
Art Unit:	2627
Confirmation No.:	7384
Customer No.:	64612 Attorney Docket No.: ST9-99-070

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Alexandria, VA 22313-1450

We are enclosing for filing in the above-identified application the following:

1. Appellant's Appeal Brief *(in triplicate)* with $500 fee;
2. Request for Extension of Time with $120.00 fee;
3. Transmittal letter in duplicate.

Please charge any additional fees or credit any such fees, if necessary to Deposit Account No. **09-0460** in the name of Ohlandt, Greeley, Ruggiero & Perle. A duplicate copy of this sheet is attached.

Respectfully submitted,

July 3, 2007
Date

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REQUEST FOR EXTENSION OF TIME

Dear Sir:

This is a petition for extension of time for a total period of one (1) month. Based on the extension requested, the extended period for response will expire on July 4, 2007.

The Commissioner is hereby authorized to charge the fee of $120.00 and any additional fees or credit any overpayment, to Deposit Account No. 09-0460. A duplicate copy of this Request is enclosed.

Respectfully submitted,

July 3, 2007
Date

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APPEAL BRIEF FILED UNDER 35 U.S.C. §134

Dear Sir:

Further to the Notice of Appeal filed on March 13, 2007, this Appeal Brief is filed under 35 U.S.C. §134(a). The claims on appeal are set forth in the attached Claims Appendix.

I. Real Party in Interest

The owner of this application is International Business Machines Corporation. Ownership of the above-references patent application is established by an assignment document recorded for the application on December 23, 1999, on Reel 010484, Frame 0282.

II. Related Appeals and Interferences

No other appeals, interferences, or judicial proceedings are known to Appellants, Appellant's Attorney, or the assignee of the application (International Business Machines Corporation), which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1 – 7 and 10 – 29 are subject to appeal. Claims 8 and 9 have been cancelled.

The Final Office Action, mailed October 13, 2006 ("Final Action"), rejected Claims 1, 10, 15, and 20 – 29 as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,911,776 to Guck (hereinafter, "Guck"), in view of U.S. Patent No. 6,629,130 to Mertama (hereinafter, "Mertama"), and Claims 2 – 7, 11 – 14, and 16 – 19 as obvious over Guck, in view of Mertama, and further in view of U.S. Patent No. 6,230,173 to Ferrel, et al. (hereinafter, "Ferrel").

Subsequent to the Final Office Action, Applicants filed a Response to Final Office Action on January 4, 2007. No claims were amended. An Advisory Action was mailed on February 9, 2007, which maintained the pending rejections. A Notice of Panel Decision from Pre-Appeal Brief Review, maintaining the pending rejections was mailed on May 3, 2007, referring the matter to the Board of Patent Appeals and Interferences.

IV. Status of Amendments

No amendments were filed in response to the Final Action. The arguments on appeal are based upon the pending claims as set forth in the attached Claims Appendix.

V. Summary of Claimed Subject Matter

As a brief introduction, computer programs have a large number of messages that must be communicated to a system operator or to a user. Some of these messages are simply informative, such as informing the user that an action has been completed, while other messages warn a user that something is not as expected, or that there has been an error or failure, such as an attempt to open a file that does not exist. The computer messages are composed by computer programmers and stored in a computer message file in a particular message format, and having format tags that indicate field delimiters, message types, etc. However, different message formats use different format tags, and so the person composing the message must have a special knowledge of formats, and take the time to accurately insert the format tags.

The subject matter in this application provides the capability for the computer programmer to compose his or her message in a regular, "unformatted" text area, without needing to add the formatting tags. After the entries are made, the "unformatted message" is converted by a message creator program into a "formatted" message having all of the proper format tags. The complete formatted message is then displayed in the display area (page 3, lines 16 – 21; see also Fig. 5, **82**). The result of this is that the invention eliminates the need for a computer message composer to have a special knowledge of SGML, book manager script, or formatted display format tags and rules (page 11, lines 7 – 11), as this information is automatically added. The invention relieves the programmer of the time-consuming burden of preparing a formatted message with format tags (page 3, lines 2 – 4), saves time in composing messages (page 3, lines 4 – 5), and reduces input error (page 3, line 4; page 11, line 13).

As required under 37 C.F.R. §41.37(v), a concise explanation of the subject matter defined in each independent claim, referring to the specification by page and line number, and to the drawings by reference character, is provided as follows:

1. Claim 1

The claimed subject matter for independent claim 1 is a method for composing a computer message including the steps of (a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text field (*see page 6, lines 8 – 17, 19 – 24; also Fig. 2, template **62**,*

*and areas **64**, **66**, **68**, **70**, etc.)*, and a message format selector for selecting an output format from a plurality of formats (*see, e.g., page 7, lines 1 – 5 and Fig. 3, **84***; see *also page 8, lines 7 – 9* and *Fig. 6, step **94***), and (b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats (*see, e.g., Fig. 8, **95***), converting said unformatted message to form a formatted message from said text field with format tags (*see page 7, lines 10 – 12; Fig. 6, **97**; Fig. 8, **100, 102, 104, 106***), wherein said formatted message is formatted according to said one of said output formats (*see page 7, lines 1 – 5; Fig. 3, **84**; Fig. 4, Fig. 5*), and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field (*see page 7, lines 12 – 21; Fig. 5, **82**; Fig. 8, **108***).

2. Claim 10

The claimed subject matter of independent claim 10 is a computer including a web page for presentation on an Intranet or an Internet (*see page 5, lines 16 – 18; Fig. 1, **30**; Fig. 6, **91, 92 93)***; and a message creator program for the composition of computer messages (see *page 5, line 10; Fig. 1, **26**; page 7, lines 10 - 11*), said message creator program performing the following steps: (a) presenting a message composition area for entry of an unformatted message into at least one text field (*see page 6, lines 12 – 24;* and *Fig. 2, **64, 64, 66, 68, 70)*** and for entry of data into at least one selection field associated with said text field, and a message format selector for selecting an output format from a plurality of formats (*see Fig. 3, **84**; page 7, lines 1 – 5; page 8,*

lines 7 – 9 and *Fig. 6, step **94**)*; and (b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message from said text field with format tags (*see page 7, lines 10 – 12; Fig. 6, **97**; Fig. 8, **100, 102, 104, 106**)*, wherein said formatted message is formatted according to said one of said output formats (*see page 7, line 12; Fig. 3, **84**; Fig. 4, Fig. 5)*, and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field (*see page 7, lines 12 – 21; Fig. 5, **82**; Fig. 8, **108**)*.

3. Claim 15

The claimed subject matter of independent claim 15 is a memory media (*see Fig. 1, **55***; page 6, lines 1 – 3) for a computer including: a controller for controlling said computer (*see Fig. 6, **91**; page 7, line 29 to page 8, line 1*) with a message creator program that performs the following steps: (a) presenting a message composition area for entry of an unformatted message into at least one text field (*see page 6, lines 8 – 17, 19 – 24; also Fig. 2, template **62**, and areas **64**, **66**, **68**, **70**, etc.)*, and for entry of data into at least one selection field associated with said text field, and a message format selector for selecting an output format from a plurality of formats (*see, e.g., page 7, lines 1 – 5 and Fig. 3, **84***; see *also page 8, lines 7 – 9* and *Fig. 6, step **94***); and (b) in response to entry of said unformatted message into said message composition area and selection of one of said output formats (*see, e.g., Fig. 8, **95**)*, converting said unformatted message to form a formatted message from said text field with format tags (*see page 7, lines 10 –*

12; Fig. 6, ***97****; Fig. 8,* ***100, 102, 104, 106****)*, wherein said formatted message is formatted according to said one of said output formats (*see page 7, line 12; Fig. 3,* ***84****; Fig. 4, Fig. 5)*, and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field (*see page 7, lines 12 – 21; Fig. 5,* ***82****; Fig. 8,* ***108****)*.

4. Claim 20

The claimed subject matter of independent claim 20 is a method for composing a computer message, said method comprising the steps of: (a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text field (*see page 6, lines 8 – 17, 19 – 24; also Fig. 2, template* ***62****, and areas* ***64, 66, 68, 70****)*, a formatted message display area (*see page 7, lines 12 – 14)* and a message format selector for selecting an output format from a plurality of formats (*see, e.g., page 7, lines 1 – 5 and Fig. 3,* ***84***; see *also page 8, lines 7 – 9* and *Fig. 6, step* ***94***); (b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats (*see, e.g., Fig. 8,* ***95****)*, converting said unformatted message to form a formatted message with format tags (*see page 7, lines 10 – 12; Fig. 6,* ***97****; Fig. 8,* ***100, 102, 104, 106****)*, wherein said formatted message is formatted according to said one of said output formats (*see page 7, lines 1 – 5; Fig. 3,* ***84****; Fig. 4, Fig. 5)*, and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field (*see page 7, lines*

12 – 21; Fig. 5, ***82****; Fig. 8,* ***108***); and (c) presenting said formatted message for display in said formatted message display area (*see page 7, lines 12 – 14, 17 – 19; Figs. 3 and 5,* ***82***).

5. Claim 21

The claimed subject matter for independent claim 21 is a method for composing a computer message, said method comprising the steps of: (a) receiving an unformatted message from a user (*page 6, lines 11 – 17; Fig. 2,* ***62, 64, 66, 68, 70, 72, 74***); (b) selecting one output format for said message from a plurality of output formats (*page 7, lines 1 – 5 and Fig. 3,* ***84****; see also page 8, lines 7 – 9* and *Fig. 6, step* ***94***); (b.2) inputting a selection field data into an associated selection field *(page 7, lines 1 – 4; Fig. 6,* ***93, 94, 95****; Fig. 7,* ***122, 124****; Fig. 3,* ***84****)*; and (c) converting said unformatted message to a formatted message having an output format selected in step b) (*see page 7, lines 10 – 12; Fig. 6,* ***97****; Fig. 8,* ***100, 102, 104, 106****)* and including format tags of said one of said output formats, wherein said formatted message is formatted according to one of said output formats *(page 7, lines 12 – 21; page 8, lines 15 – 17; Fig. 4,* ***82****)*, and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on said selection field data from said associated selection field *(page 7, lines 18 – 21; Figs. 3, 4, & 5:****82****).*

6. Claim 23

The subject matter of independent claim 23 is a memory media controlling a computer *(page 6, lines 1 – 3; Fig. 1,* ***55***) to compose a computer message, where the memory media

includes: (a) a controller for controlling said computer to receive an unformatted message from a user *(Fig. 6, **91**; page 7, line 29 to page 8, line 1)*; (b) a selector responsive to a user input to control said computer to select one output format for said message from a plurality of output formats *(page 7, lines 1 – 5; Fig. 3, **84**;Fig. 6, **94**)* and an input for inputting a selection field data into an associated selection field; and (c) a convertor for controlling said computer to convert said unformatted message to a formatted message having an output format selected in step b) *(page 7, lines 10 – 12; Fig. 6, **97**; Fig. 8, **100**, **102**, **104**, **106**)* and including format tags of said one of said output formats, wherein said formatted message is formatted according to one of said output formats *(page 7, line 12; Fig. 3, **84**; Figs. 4 & 5)*, and wherein format tags are assigned to said formatted message and said formatted message is structured for display based on said selection field data from said associated selection field *(page 7, lines 12 – 21; Fig. 5, **82**; Fig. 8, **108**)*.

7. Claim 25

The subject matter of independent claim 25 is a method for composing a computer message, said method comprising the steps of: (a) presenting a first message composition area for entry of an unformatted plain text message *(see page 6, lines 8 – 17, 19 – 24; also Fig. 2, template **62**, and areas **64**, **66**, **68**, **70**)*, and a message format selector for selecting an output format from a plurality of message formats *(page 7, lines 1 – 5; page 8, lines 7 – 9; Fig. 3, **84**; Fig. 6, **94**)*, wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area *(page 6, lines 9 – 10, lines 29 – 31)*;

(b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats (*Fig. 8, **95)***, converting said unformatted plain text message to form a formatted message with format tags *(page 7, lines 10 – 12; Fig. 6, **97**; Fig. 8, **100, 102, 104, 106)*** of said one of said output formats, wherein said unformatted plain text message is a first unformatted plain text message, said formatted message is a first formatted message, said first message composition area further includes a formatted display area *(Fig. 2, **66, 68, 70, 72, 74**; Figs. 3 – 5, **82)***; (c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of said one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats*(Fig.3, **82**; Fig. 8, **100, 102, 104, 106)***; and (d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area *(page 7, lines 7 – 14; Fig. 3, **84)***.

8. Claim 26

The subject matter of independent claim 26 is a computer comprising: a web page for presentation on an Intranet or an Internet *(see page 5, lines 16 – 18; Fig. 1, **30**; Fig. 6, **91, 92 93)***; a message creator program for the composition of computer messages (see *page 5, line 10; Fig. 1, **26**; page 7, lines 10 - 11*), said message creator program performing the following steps: (a) presenting a first message composition area for entry of an unformatted plain text message

(*see page 6, lines 12 – 24;* and *Fig. 2,* ***64, 64, 66, 68, 70)*** and a message format selector for selecting an output format from a plurality of message formats wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area *(see, e.g., Fig. 2,* ***76)***; (b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags (*see page 7, lines 10 – 12; Fig. 6,* ***97****; Fig. 8,* ***100, 102, 104, 106)*** of said one of said output formats, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area; (c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message *(page 6, lines 14 – 16)* to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats *(page 7, lines 7 – 14; Fig. 3, 4, & 5,* ***82****; Fig. 6,* ***97)***; and (d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area (*page 7, lines 10 – 13)* .

9. Claim 27

The subject matter of independent claim 27 is a memory media for a computer *(page 6, lines 1 – 3; Fig. 1,* ***55****)*, said memory media comprising: a controller for controlling said computer *(Fig. 6,* ***91****; page 7, line 29 to page 8, line 1)* with a message creator program that

performs the following steps: (a) presenting a first message composition area for entry of an unformatted plain text message *(see, e.g., page 6, lines 11 – 17; Fig. 2,* ***64, 66, 68, 70, 74)*** and a message format selector for selecting an output format from a plurality of message formats *(page 7, lines 1 – 5; Fig. 3,* ***84),*** wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area *(see, e.g., Fig. 2,* ***76)***; (b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats *(page 7, lines 7 – 14; Fig. 3, 4, & 5,* ***82****; Fig. 6,* ***97)***, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area *(page 7, lines 16 – 21; Figs. 4 & 5,* ***82)***; (c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats *(Fig. 8,* ***100, 102, 104, 106)***; and (d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area *(page 7, lines 10 – 14).*

10. Claim 28

The subject matter of independent claim 28 is a method for composing a computer message, said method comprising the steps of: (a) presenting a first message composition area for entry of an unformatted plain text message *(page 7, lines 11 – 24; Fig. 2, **64, 66, 68, 70, 74)*** and a message format selector for selecting an output format from a plurality of message formats (*Fig. 3, **84**;page 7, lines 1 – 5)* wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area (*see, e.g., Fig. 2, **76)***; (b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags *(fig. 6, **97**; Fig. 8, **100, 102, 104, 106)*** of said one of said output formats, wherein said unformatted plain text message is a first unformatted plain text message *(page 6, lines 13 – 15)*, said formatted message is a first formatted message, said first message composition area further includes a formatted display area *(Figs. 3 – 5; **82)***; (c) converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats (*Fig. 6, **97**; Fig. 8, **100, 102, 104, 106)***; and (d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted display area (*see, e.g., page 7, lines 9 – 11).*

11. Claim 29

The subject matter of independent claim 29 is a method for composing a computer message, said method comprising the steps of: (a) receiving an unformatted plain text message from a user *(page 6, lines 11 – 17; Fig. 2, **64**, **66**, **68**, **70**, **74**)*; (b) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of message formats *(page 7, lines 1 – 5; Fig. 3, **84**)* wherein said message formats further include a first formatted display (*Fig. 3, **82***) and wherein step (b) further presents a second message composition area (*see, e.g., Fig. 2, **76**, **78***); (c) converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats *(Fig. 6, **97**; Fig. 8, **100**, **102**, **104**, **106**; page 7, lines 9 – 14)*, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area (*Figs. 3 – 5, **82***) (d) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats *(Fig. 6, **97**; Fig. 8, **100**, **102**, **104**, **106**; page 7, lines 9 – 14)*; and (e) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area *(page 7, lines 10 – 13)*.

VI. Grounds of Rejection to be Reviewed on Appeal

The issues to be reviewed on appeal are: (1) whether claims 1, 10, 15, and 20 – 29 are obvious under 35 U.S.C. §103(a) in view of U.S. Patent No. 5,911,776 to Guck and U.S. Patent No. 6,629,130 to Mertama, et al.; and (2) whether claims 2 – 7, 11 – 14, and 16 – 19 are obvious in view of Guck, Mertama, et al., and U.S. Patent No. 6,230,173 to Ferrel, et al.

VII. Argument

A. Rejections to claims 1, 10, 15, and 20 – 29 under 35 U.S.C. §103(a) in view of U.S. Patent No. 5,911,776 to Guck and U.S. Patent No. 6,629,130 to Mertama, et al.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success and (3) the prior art references when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 recites, in part, a "...message composition area for entry of an **unformatted message**" [emphasis added]. Claim 1 further recites, in part, that "...in response to the entry of an **unformatted message**...**converting said unformatted message to form a formatted message**...**with format tags**...wherein format tags are assigned to said formatted message and said formatted message is structured for display based on selection field data from said at least one associated selection field." [emphasis added].

Guck discloses a network providing a server that enables an author to create and store an original formatted (col. 4, lines 41 – 43) document as a "source" file which is a designated "object" in an object-oriented database (OODB). Guck provides a second type of file, which he designates as a "shadow" file, without content of its own, but rather is simply dedicated to a particular output format. The shadow file "points" to the "source" file, and also points to a "converter" (col. 4, lines 49 – 50). It is the "converter" that transforms the formatted content of the source file into another file having the desired format (col. 4, lines 41 – 54). However, Guck does not disclose or suggest a method for composing a computer message that provides a "message composition area for entry of an **unformatted message** into a text field," nor "converting said **unformatted message** to form a formatted message...with format tags," as recited in claim 1.

Guck does not use the term "unformatted" anywhere in the disclosure. However, the Final Office Action identified a passage about creating a message or document in "his own format" or

in a "personal format" as an untagged – and therefore an "unformatted" – text environment. Specifically as to claim 1, the Final Office Action at page 3 stated that Guck discloses that "...an author could originate a **text message of his own personal format**" [emphasis added], that Guck discloses "composing a computer message...comprising the steps of (a) presenting a message composition area for entry of an unformatted into one text field...," and that Guck "teaches an author can create its own message or document in his own format such as Rich Text Format (RTF) (unformatted)..." However, both of these propositions are in error. The Final Office Action erred by equating creating a formatted message in a "personal format" as rendering obvious creating an "unformatted message" that is later converted into a formatted message;. Also, as disclosed in Guck, RTF is not an "unformatted" format.

And, for the same reasons, the Advisory Action was likewise in error for maintaining the rejection to claim 1 by stating that "Guck teaches a message in a **personal format** which is **unknown to the receiving application**," and concluding that "...It would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that the data in a **personal format** of Guck was **unformatted for the receiving application**, providing the benefit of allowing the data to be converted to an appropriate format according to the needs of the receiving application." [emphasis added] (Advisory Action of February 9, 2007, at page 2, *citing* Guck, col. 6, lines 10 – 28). However, the Advisory Action errs on these points, because a formatted message that is "unknown" to the receiving application is still a formatted message and does not become an "unformatted" message for the receiving application.

Specifically, Guck discloses the idea of a programmer composing a message in a "personal format" in this context:

> "It would be most desirable to provide a network where any client, **no matter what format his document consists of**, or what his personal computer protocol utilizes, could create, originate, or author a document and **enable this document's content to be transmitted to and received by** personal computer clients or appliances **using different types of protocol** so as to be received by appliance such as FAX machines, telephones and E-Mail users. Heretofore, this has not been done with any great efficiency whereby an originator or author **could originate a text or message in his own personal format** and using his personal appliance protocol, and send it to multiple receiver users…after it has been **automatically processed and handled** by a **server** which **distributes his origination in any and all formats** necessary to be received…" [emphasis added] (Guck, col. 2, lines 1 – 17).

A careful reading of this passage demonstrates that Guck is disclosing a system where a document in one format ("his own personal format"), using his own appliance's protocol, can be transmitted and received by an appliance even if using any other format. The emphasis is that the server can "automatically process[ ]and handle[ ]" the formatted text and the protocol so that the message can be received by multiple receivers no matter the original format or protocol. But Guck never discloses or suggests, the "entry of an unformatted message," as in the present claim 1, nor "…in response to the entry of an unformatted message…converting said unformatted message to form a formatted message…with format tags," recited in claim 1.

The Final Office Action also erred for interpreting Guck as teaching "…an author can create its own message or document in his own format such as **Rich Text Format (RTF)**

(unformatted)." Later, the Final Office Action states that Guck "teaches converting Rich Text format (an untagged format) into TIFF (a tagged format)." By inference, the effect of this statement is to present RTF as an "untagged" format that is thereby "unformatted," which is an incorrect inference in this context. The Guck reference itself expressly teaches against the inference that RTF is unformatted. Guck presents a hypothetical working example where a user-author generates a document with content "...using the **common universal format designated as RTF**." [emphasis added] (col. 6, lines 65 – 67). Guck discloses that "...this designates **'Rich Text Format' which is a Microsoft standard for encoding formatted text and graphics**." [emphasis added] (col. 7, lines 1 – 2). Guck then continues, "Now, if the user wishes to send this document onto a FAX machine, it would be necessary to **convert the RTF format** into **another format such as TIFF**." [emphasis added] (col. 7, lines 2 – 5). Guck's own disclosure is that RTF is a formatted environment, and rebuts any inference that Guck discloses or suggests that creating an original message in RTF constitutes creating an "unformatted" message.

Accordingly, the Final Office Action provides no reasonable basis to interpret Guck's disclosure as anything other than the translation of one formatted message to another formatted message. Guck therefore fails to disclose or suggest any of the elements in claim 1 using an "unformatted message." Moreover, as acknowledged in the Final Office Action, Guck fails to teach "...wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data...," as recited in claim 1.

The second cited reference, Mertama, is directed to a method for implementing electronic

mail services (col. 1, lines 6 – 8). The Mertama system parses the structure of electronic mail messages, and then informs the client about the structure of the e-mail message and attributes relating to the content of the structural parts (col. 3, lines 3 – 7; col. 5, lines 36 – 38). The electronic mail message is identified by means of a tag, which unambiguously identifies the message in the mailbox (col. 5, lines 41 – 42). Of note, the receiving terminal analyzes the format of the electronic mail message **and checks the need for conversion** (col. 5, lines 46 – 48) [emphasis added]. If conversion is necessary, the server carries out the selected conversion and **gives the converted electronic mail message a new identifying tag** and stores the message in a mailbox (col. 5, lines 53 – 63) [emphasis added]. When such a conversion occurs, the server informs the client of the conversion and the new tag (col. 5, lines 63 – 67), and the user can decide if further processing of the message (such as converting into a specific text format) is desired (col. 6, lines 1 – 4). Moreover, the tags disclosed in Mertama are "identifying" tags, *not* "formatting" tags (col. 5, lines 40 – 43 and lines 60 – 61).

However, Mertama does not disclose or suggest a method for presenting a message composition area having a text field for entry of an **unformatted** message (or entry of data in a **selection field** associated with the text field, or a **message format selector** for selecting an output format), nor converting the unformatted message to a formatted message…with **format tags**," as provided in claim 1. And, as noted above, Mertama's "tags" are identifying tags, not formatting tags.

For these reasons, Mertama does not supplement the deficiencies in Guck to address every

limitation recited in claim 1. Accordingly, Guck and Mertama, taken alone or in combination, fail to disclose or suggest a "message composition area for entry of an unformatted message," or "converting said unformatted message to form a formatted message …with format tags," as recited in the present claim 1. The Final Office Action thereby fails to establish a *prima facie* case for obviousness. Moreover, even if the recited elements relating to unformatted messages had been present, there were considerable differences between the operation of Guck and Mertama (and even in their uses of formatting tags), and it is unlikely that a person of skill in the art would have been motivated to combine these two references in such a way as to anticipate the elements in claim 1, without benefit of hindsight.

Therefore, for the above reasons, Applicant submits that the Final Office Action was in error for rejecting claim 1 as obvious over Guck and Mertama. Similarly, each claim 10, 15, and 20 – 29 are also patentable in view of U.S. Patent No. 5,911,776 to Guck and U.S. Patent No. 6,629,130 to Mertama, et al., so the same reasons set forth above with regard to claim 1.

B. Rejections to claims 2 – 7, 11 – 14 and 16 – 19 under 35 U.S.C. §103(a) in view of: U.S. Patent No. 5,911,776 to Guck; U.S. Patent No. 6,629,130 to Mertama, et al.; and U.S. Patent No. 6,230,173 to Ferrel, et al.

The applicable law, as before, is that, to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three criteria must be met: (1) there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success and (3) the prior art references when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the outstanding Office Action erroneously attempt to suggest that dependent claims 2 – 7, 11 – 14, and 16 – 19 are obvious in view of Guck, Mertama, et al., as discussed above with regard to the independent claims, and further in view of U.S. Patent No. 6,230,173 to Ferrel et al. However, dependent claims 2 – 7, 11 – 14, and 16 – 19 fail to overcome the substantial deficiencies discussed above with regard to the Guck and Mertama et al. references. Accordingly, Applicant respectfully submits that the teachings of Ferrel et al. does not make obvious that which is recited in dependent claims 2 – 7, 11 – 14, and 16 – 19.

That is, the Final Office Action acknowledged that the combination of Guck and Mertama did not expressly disclose that the "message formats include SGML and book manager script." (Final Office Action at page 5). The Office Action attempts to overcome the deficiencies of the primary references by adding yet a third reference to Ferrel et al.

However, Ferrel et al. only discloses electronic publishing systems for creating on-line

stories (col. 3, lines 39 – 40). The systems have a story editor that is able to save files in a Multimedia Document Format (MDF). These multi-media files are then used to provide content for displayed online titles for a Multimedia Publishing System (col. 3, lines 42 – 45). Ferrel also discloses a method for translating Rich Text Format (RTF) files into MDF format using a pair of converters (col. 3, lines 47 – 48). However, as outlined in the discussion for independent claim 1, RTF is a standard for encoding **formatted** text and graphics; in other words, Ferrel discloses a method for translating files from one format to another. Ferrel, taken alone and/or in combination with Guck and Mertama, does not disclose converting an unformatted message to form a formatted message where the message formats are SGML or book manager script.

Accordingly, Guck, Mertama, and Ferrel, et al. taken alone or in combination, fail to disclose every limitation of dependent claims 2 – 7, 11 – 14, and 16 – 19. Therefore, Applicant submits that the Final Office Action was in error for rejecting dependent claims 2 – 7, 11 – 14, and 16 – 19 as obvious over Guck, in view of Mertama and Ferrel et al.

IX. Summary

Accordingly, Applicant respectfully requests that the Board of Patent Appeals & Interference reverse the final rejection of claims 1 – 7 and 10 – 29, thereby enabling all of the pending claims to be allowed. In addition, claims 1-7 and 10-29 should be grouped together in this appeal.

7/3/07
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CLAIMS APPENDIX

1. A method for composing a computer message, said method comprising the steps of:

(a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text field, and a message format selector for selecting an output format from a plurality of formats; and

(b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message from said text field with format tags,

wherein said formatted message is formatted according to said one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field.

2. The method of claim 1, wherein said message formats include SGML and book manager script.

3. The method of claim 2, wherein said message formats further include formatted display.

4. The method of claim 3, wherein computer instructions for steps (a) and (b) are implemented in Java script.

5. The method of claim 3, wherein said unformatted message is a first unformatted message, said formatted message is a first formatted message, said message composition area further includes a formatted display area and wherein step (a) further presents a second message composition area; further comprising:

(c) in response to entry of a second unformatted message into said second message composition area, converting said unformatted message to form a formatted message with format tags of said one of said output formats; and

(d) presenting said first and second formatted messages as a concatenated complete message for display in said formatted message display area.

6. The method of claim 5, further comprising:

(e) editing said first and second formatted messages in said formatted message display area, if needed; and

(f) sending a copy of said formatted message to a computer message file.

7. The method of claim 6, wherein said first and second composition areas and said formatted message display area are formed in a template that is presented on a web page, and wherein steps (e) and (f) are performed via said web page.

8. – 9. (Cancelled)

10. A computer comprising:

a web page for presentation on an Intranet or an Internet; and

a message creator program for the composition of computer messages, said message creator program performing the following steps:

(a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text

field, and a message format selector for selecting an output format from a plurality of formats; and

(b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message from said text field with format tags,

wherein said formatted message is formatted according to said one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field.

11. The computer of claim 10, wherein said message formats include SGML and book manager script.

12. The computer of claim 11 wherein said message formats further include formatted display.

13. The computer of claim 12, wherein computer instructions for steps (a) and (b) are

implemented in Java script.

14. The computer of claim 12, wherein said unformatted message is a first unformatted message, said formatted message is a first formatted message and said message composition area includes a formatted message display area, and wherein step (a) further presents a second message composition area, and wherein said message creator program further comprises:

(d) in response to entry of a second unformatted textual message in said second message composition area, converting said second unformatted message into said selected one of said formats to form a second formatted message; and

(e) presenting said first and second formatted messages as a concatenated complete message for display in said formatted message display area.

15. A memory media for a computer, said memory media comprising:

a controller for controlling said computer with a message creator program that performs the following steps:

(a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text

field, and a message format selector for selecting an output format from a plurality of formats; and

(b) in response to entry of said unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message from said text field with format tags,

wherein said formatted message is formatted according to said one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field.

16. The memory media of claim 15, wherein said message formats include SGML and book manager script.

17. The memory media of claim 16 wherein said message formats further include formatted display.

18. The memory media of claim 16, wherein computer instructions for steps (a) and (b)

are implemented in Java script.

19. The memory media of claim 18, wherein said unformatted message is a first unformatted message, said formatted message is a first formatted message, said message composition area includes a formatted message display area and wherein step (a) further presents a second message composition area, and wherein said message creator program further comprises:

(c) in response to entry of a second unformatted textual message in said second message composition area, converting said second unformatted message into said selected one of said formats to form a second formatted message; and

(d) presenting said first and second formatted messages as a concatenated complete message for display in said formatted message display area.

20. A method for composing a computer message, said method comprising the steps of:

(a) presenting a message composition area for entry of an unformatted message into at least one text field and for entry of data into at least one selection field associated with said text field, a formatted message display area and a message format selector for selecting an output format from a plurality of formats;

(b) in response to entry of an unformatted message into said message composition area and selection of one of said output formats, converting said unformatted message to form a formatted message with format tags,

wherein said formatted message is formatted according to said one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on a selection field data from said at least one associated selection field; and

(c) presenting said formatted message for display in said formatted message display area.

21. A method for composing a computer message, said method comprising the steps of:

(a) receiving an unformatted message from a user;

(b) selecting one output format for said message from a plurality of output formats;

(b.2) inputting a selection field data into an associated selection field; and

(c) converting said unformatted message to a formatted message having an output format selected in step b) and including format tags of said one of said output formats,

wherein said formatted message is formatted according to one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on said selection field data from said associated selection field.

22. The method as recited in claim 21, further comprising the added step of:

(d) displaying said formatted message for user review.

23. A memory media controlling a computer to compose a computer message, said memory media comprising:

(a) a controller for controlling said computer to receive an unformatted message from a user;

(b) a selector responsive to a user input to control said computer to select one output

format for said message from a plurality of output formats and an input for inputting a selection field data into an associated selection field; and

(c) a convertor for controlling said computer to convert said unformatted message to a formatted message having an output format selected in step b) and including format tags of said one of said output formats,

wherein said formatted message is formatted according to one of said output formats, and

wherein format tags are assigned to said formatted message and said formatted message is structured for display based on said selection field data from said associated selection field.

24. The memory media as recited in claim 23, further comprising:

(d) a display control for controlling said computer to display said formatted message for user review.

25. A method for composing a computer message, said method comprising the steps of:

(a) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of

message formats, wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area;

(b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats, wherein said unformatted plain text message is a first unformatted plain text message, said formatted message is a first formatted message, said first message composition area further includes a formatted display area;

(c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of said one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats; and

(d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area.

26. A computer comprising:

a web page for presentation on an Intranet or an Internet;

a message creator program for the composition of computer messages, said message creator program performing the following steps:

(a) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of message formats wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area;

(b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area;

(c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats; and

(d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area.

27. A memory media for a computer, said memory media comprising:

a controller for controlling said computer with a message creator program that performs the following steps:

(a) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of message formats wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area;

(b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area;

(c) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats; and

(d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area.

28. A method for composing a computer message, said method comprising the steps of:

(a) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of message formats wherein said message formats further include a first formatted display and wherein step (a) further presents a second message composition area;

(b) in response to entry of said unformatted plain text message into said first message composition area and a selection of one of said output formats, converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats, wherein said unformatted plain text message is a first unformatted plain text message, said formatted message is a first formatted message, said first message composition area further includes a formatted display area;

(c) converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats; and

(d) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted display area.

29. A method for composing a computer message, said method comprising the steps of:

(a) receiving an unformatted plain text message from a user;

(b) presenting a first message composition area for entry of an unformatted plain text message and a message format selector for selecting an output format from a plurality of message formats wherein said message formats further include a first formatted display and wherein step (b) further presents a second message composition area;

(c) converting said unformatted plain text message to form a formatted message with format tags of said one of said output formats, wherein said unformatted plain text message is a first unformatted massage, said formatted message is a first formatted message, said first message composition area further includes a formatted display area;

(d) in response to an entry of a second unformatted plain text message into said second message composition area, converting said first unformatted plain text message to form a first formatted message with format tags of one of said output formats and a second unformatted plain text message to form a second formatted message with format tags of said one of said output formats; and

(e) presenting said first and second formatted messages as a concatenated complete single message for display in said formatted message display area.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.